REMARKS

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 are pending in the instant Application.

CLAIM FOR PRIORITY UNDER 35 U.S.C. § 120

Applicants thank the Patent Office for acknowledging the claim for priority under 35 U.S.C. § 120.

INFORMATION DISCLOSURE STATEMENT

The Patent Office alleged that since the Information Disclosure Statement submitted on February 25, 2002 failed to comply with 37 CFR § 1.98(a)(2) that the information referred to therein was not considered.

Applicants refer the Patent Office to 37 CFR § 1.98(d) and respectfully request consideration of the information submitted in the Information Disclosure Statement, filed on February 25, 2002.

ATTACHMENTS FOR RESPONSE MAILED OCTOBER 30, 2002

The Patent Office acknowledged filing of Attachments for Response Mailed October 30, 2002 but stated that the information in the enclosed references has not been considered. Applicants point out that enclosed references were submitted to clarify the ordinary meaning of antioxidant and to provide evidence that oxygen and radical scavenging by gallic acid esters is a chemical reaction and not as art relevant to patentability of the claims of the current application. Accordingly, Applicants will not submit the references enclosed in Attachments for Response Mailed October 30, 2002 in an Information Disclosure Statement.

REJECTION UNDER 35 U.S.C. § 112, first paragraph

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 stand rejected under 35 U.S.C. § 112, first paragraph because the specification while being enabling for a method of formulating or reformulating a drug which is subject to CYP3A biotransformation does not reasonably provide enablement for the term "reformulating an existing oral pharmaceutical composition." The Patent Office further alleged that the specification did not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicants respectfully traverse the rejection.

In order to satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph a patent application, supplemented with information known in the art, need only teach one of ordinary skill in the art how to make and use the invention, without conducting undue experimentation. The patent disclosure is not required to teach, and preferably omits that which is well known in the art. *In re Buchner* 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.* 231 USPQ 81, 94 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.* 221 USPQ 481, 489 (Fed. Cir. 1984). Experimentation typically engaged in by those of skill in the art is permitted, as long as the experimentation is not undue. *In re Wands* 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Angstadt* 190 USPQ 214, 219 (CCPA 1976).

A disclosure, as filed, is presumed to be enabled, unless there is reason to objectively doubt the truth of the statements relied on for enabling support. *In re Marzocchi* 169 USPQ 367, 370 (CCPA 1971). Thus, the Patent Office bears the initial burden of presenting a reasonable explanation of why the scope of protection sought in the claims is not enabled by the specification. *In re Wright* 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

As an initial matter, Applicants submit that the phrase "reformulating an existing oral pharmaceutical composition" is not present in Claims 23, 32-36, 38-40 and 58. Since the Patent Office has failed to present any explanation whatsoever for rejecting Claims 23, 32-36, 38-40 and 58 under 35 U.S.C. § 112, first paragraph, the initial presumption of an enabling disclosure has not been rebutted. *In re Marzocchi* 169 USPQ at 370. Further, the Patent Office has failed to provide any reason for objectively doubting the validity of any statements relied on for enabling support with regards to Claims 43, 52-55 and 59 and thus has failed to rebut the initial presumption of an enabling disclosure for these Claims. Accordingly, the Patent Office has not met the initial burden of presenting a reasonable explanation of why the scope of protection sought in the claims is not enabled by the specification. Therefore, there is "no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure" in regard to these pending Claims. *Id.*

Nevertheless, in the interests of expediting prosecution, Applicants submit that Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 are fully enabled by the Specification, as filed. Applicants teach how to measure bioavailability, (Specification, page 6, line 27 to page 7, line 15) and pharmaceutical compounds (*i.e.*, "drugs") (Specification page 7, line 20 to page 8, lines 8-14). Applicants also submit that oral pharmaceutical compositions

are taught in the Specification (page 15, lines 29 to page 17, line 21) and are also well known to the skilled artisan. Therefore, the Specification teaches how to make and use the invention recited in Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59, without undue experimentation. Nothing more is required under 35 U.S.C. § 112, first paragraph.

Applicants now address an issue raised in the rejection of all pending Claims under 35 U.S.C. § 112, first paragraph. The Patent Office claimed on page 5 of the instant Office Action that

> "the instant specification fails to provide adequate direction or guidance regarding whether said gallic acid ester can be practiced with other drugs that are not subject to P450 CYP3A metabolism. The specification fails to provide sufficient information regarding how to formulate non-P450 CYP3A biotransformation drug with said gallic acid ester. The breadth of the instant claims includes not only drugs that undergoes P450 CYP3A metabolism but also non-P450 CYP3A biotransformation drug. The specification disclosure is insufficient to enable one skilled in the art to practice the invention without undue experimentation."

Applicants remind the Patent Office that pending independent Claims 23, 43, 58 and 59 fail to recite any limitation related to P450-CYP3A. Instead these Claims recite that "the gallic acid ester being present in sufficient amount to provide bioavailability of the pharmaceutical compound in the presence of the gallic acid ester greater than the bioavailability of the pharmaceutical compound in the absence of the gallic acid ester when the pharmaceutical composition is administered orally to a mammal." The above limitation is full enabled by the Specification, as filed. Accordingly, the above comments regarding P450-CYP3A are inapposite.

Applicants further point out that every possible embodiment of a generic claim need not be exemplified in the Specification. Applicants are not required by 35 U.S.C. § 112, first paragraph to provide guidance or working examples of every possible embodiment of the invention.

For the reasons advanced above, Applicants submit that the Specification teaches how to make and use the invention recited in Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 , without undue experimentation, which is the legal standard for enablement under 35 U.S.C. § 112, first paragraph. In view of the foregoing, Applicants respectfully request that the rejection of Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 under 35 U.S.C. § 112, first paragraph be withdrawn.

REJECTION UNDER 35 U.S.C. § 112, second paragraph

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim then subject matter which applicant regards as the invention. More particularly the Patent Office alleged that in Claim 55 it was not clear which components should be present in the reformulated oral composition. Applicants respectfully traverse the rejection.

Claim 55 claims a reformulated oral composition that contains less than all the components of the existing pharmaceutical composition plus the gallic acid ester. The above-referenced claim cover pharmaceutical compositions in which one or more of the components of the existing pharmaceutical composition is absent. Such a claim encompasses a clearly defined set of possible combinations and is not indefinite.

In view of the foregoing, Applicants respectfully request that the rejection of Claim 55 under 35 U.S.C. § 112, second paragraph be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Salatinjants, United States Patent No. 4,716,173 (hereinafter "Salatinjants"). Applicants traverse the rejection.

Anticipation of a claim requires that the reference teach every element of the claim. MPEP § 2131. Thus, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California* 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As an initial point, Applicants point out that Claims 58 and 59 fail to recite tannic acid Hence, since Salatinjants fails to teach each and every limitation of the above Claims, the cited reference fails to anticipated the invention recited in these Claims .

In view of the foregoing, Applicants respectfully request that the rejection of Claims 58 and 59 under 35 U.S.C. § 102 (b) over Salatinjants be withdrawn.

The present claims are directed toward a method of formulating an oral pharmaceutical composition, or reformulating an existing pharmaceutical composition, with a gallic acid ester in order to increase bioavailability of the active compound present in the pharmaceutical composition. The bioavailability of a drug is the fraction of the oral dose that reaches bodily fluids (*i.e.*, serum, plasma or blood and the tissues bathed by

the systemic fluids, including the skin) in an active, unchanged form (Specification, page 1, lines 24-25). Accordingly, the present invention refers to increasing the systemic drug concentration over time where systemic drug concentration refers to the concentration of drug present in the bodily fluids, such as serum, plasma or blood and the tissues bathed by the systemic fluids, including the skin (Specification, page 3, lines 23-29; page 7, lines 10-16).

Salatinjants discloses that tannic acid, in conjunction with several other compounds, prolongs the residence time of drugs in the plasma of mammals, which is not the same as increasing the bioavailability of a drug (*i.e.*, the fraction of the oral dose that reaches the circulation in an active, unchanged form). Salatinjants thus teaches maintaining drug concentration in plasma as a function of time, not increasing the fraction of the oral dose that reaches bodily fluids as taught by the present invention. Accordingly, Salatinjants fails to anticipate Claims 23, 32-36, 38-40, 43 and 52-55 since the reference does not teach each and every limitation of the claimed invention.

In view of the foregoing, Applicants respectfully request that the rejection of Claims 23, 32-36, 38-40, 43 and 52-55 under 35 U.S.C. § 102 (b) over Salatinjants be withdrawn.

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Shimamura *et al.*, United States Patent No. 5,807,564 (hereinafter "Shimamura"). Applicants traverse the rejection.

Shimamura teaches combination therapy with tea catechins and various antibiotics to treat methicillin resistant *Staphylococcus aureus*. Here an effective antibiotic amount of an antibiotic are administered to a patient in combination with a synergistic amount of a catechin (Shimamura, column 1, lines 45-51; column 3, lines 43-50). Importantly, Shimamura teaches that tea catechins and tea extracts demonstrate antibacterial activity against methicillin resistant *Staphylococcus aureus* (Shimamura, column 1, lines 30-39).

Significantly, Shimamura fails to teach that tea catechins and tea extracts increase the bioavailability of antibiotics when formulated as an oral pharmaceutical composition. Accordingly, since the present claims are directed toward a method of formulating an oral pharmaceutical composition, or reformulating an existing pharmaceutical composition, with a gallic acid ester in order to increase bioavailability of the active compound present in the pharmaceutical composition Shimumura fails to anticipate the present invention.

In view of the foregoing, Applicants respectfully request that the rejection of Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 under 35 U.S.C. § 102 (b) over Shimamura be withdrawn.

Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Xiong *et al.*, United States Patent No. 5,807,564 (hereinafter "Xiong"). Applicants traverse the rejection.

Xiong teaches that the medicinal properties of green tea plants are greatly improved when a concentrated extract thereof is prepared and delivered to the body in an effervescent solution (Xiong, column 4, lines 7-10). Further, the cited reference teaches that the liquid form of administration as well as the effervescent properties of the dissolved formulation increase the bioavailability of the advantageous components of the green tea plants such as polyphenols by increasing the absorption speed and amount in the body (Xiong, Abstract).

Hence, Xiong teaches a formulation which increases the bioavailability of green tea polyphenols not a method of using of gallic acid esters to increase the bioavailability of other pharmaceutical compounds in a pharmaceutical composition, as claimed in the present invention. Accordingly, Xiong fails to teach every element of the invention claimed in the present application and thus is not an anticipatory reference.

In view of the foregoing, Applicants respectfully request that the rejection of Claims 23, 32-36, 38-40, 43, 52-55, 58 and 59 under 35 U.S.C. § 102 (e) over Xiong be withdrawn.

Applicants respectfully submits that all pending Claims of the captioned Application satisfy all requirements for patentability and are in condition for allowance. An early indication of the same is therefore respectfully requested.

No fees are believed due in connection with this Amendment beyond the Petition to Extend Time. However, the Commissioner is authorized to charge any required fee not included with this Amendment or credit any overpayment to Deposit Account No. 03-3117.

If the Examiner determines that prosecution of the instant application would benefit from a telephone interview, the Examiner is invited to call the undersigned attorney at (650) 843-5876.

Date: August 12, 2003

Respectfully submitted,
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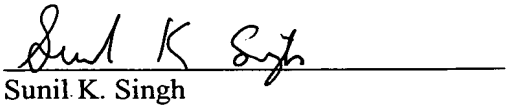
By: 

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